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In re application of : Toshihiko MUNETSUGU et al.

Attorney Docket No. P21107
Mail Stop Amendment

Serial No. : 09/877,035

Group Art Unit : 2176

Filed : June 11, 2001

Examiner : Quoc A. TRAN

For : DATA PROCESSING APPARATUS AND DATA
 PROCESSING METHOD

Mail Stop Amendment

Commissioner for Patents
 U.S. Patent and Trademark Office
 Customer Service Window, Mail Stop Amendment
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Sir:

Transmitted herewith is a **Reply Brief Under 37 C.F.R. §41.37** in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ An Information Disclosure Statement, PTO Form 1449, and references cited.
- ☐ A Request for Extension of Time.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 14	*20	0	X25=	\$	x 50=	\$0.00
Indep. Claims: 2	**3	0	X100=	\$	X200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Appeal Brief fee				\$		\$0.00
Total:				\$	Total:	\$0.00

* If less than 20, write 20

** If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☐ N/A A Check in the amount of \$_____ to cover the filing fee(s) is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Steven Wegman
 Reg. No. 31,438

Bruce H. Bernstein
 Reg. No. 29,027

P21107.A13



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Toshihiko MUNETSUGU et al. Group Art Unit: 2176
Serial No: 09/877,035 Examiner: Quoc A. TRAN
Filed: June 11, 2001 Confirmation No.: 9810
For: DATA PROCESSING APPARATUS AND DATA PROCESSING
METHOD

REPLY BRIEF UNDER 37 C.F.R. §41.41

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's Answer, dated May 16, 2006, to the Appeal Brief filed February 23, 2006, Appellants submit the present Reply Brief within the two-month response period expiring on July 17, 2006 (July 16, 2006 being a Sunday).

Remarks begin on page 2 of this paper.

REMARKS

As an initial matter, Appellants note that at page 9 of the Examiner's Answer, the Examiner acknowledges that the rejection of claims 12, 13, 21 and 26 under 35 U.S.C. §112, 1st and 2nd paragraphs is improper and indicates that the 35 U.S.C. §112, 1st and 2nd paragraph rejections have been withdrawn. Appellants thank the Examiner for withdrawing these grounds of rejection.

Other than the withdrawal of the 35 U.S.C. §112, 1st and 2nd paragraph rejections of claims 12, 13, 21 and 26, the "Grounds of Rejection" section at pages 3-8 of the Examiner's Answer indicates that the rejections are substantially identical to the grounds of rejection set forth in the Final Official Action mailed on August 24, 2005. Appellants respectfully submit that the Appeal Brief filed February 23, 2006 has fully addressed the reasons the 35 U.S.C. §103 rejection of claims 1-4, 11-13 and 21-27 is improper. Accordingly, the herein-contained remarks are merely supplemental to the Appeal Brief filed on February 23, 2006. In order to facilitate review of this Reply Brief, the present remarks are limited to addressing the additional remarks found at pages 8-15 of the Examiner's Answer.

Rejection of independent claims 1 and 11 under 35 U.S.C. §103(a) over DAVIS et al. (U.S. Patent No. 5,969,716) in view of JAIN et al. (U.S. Patent No. 6,360,234)

At pages 9-11 of the Examiner's Answer, the Examiner responds to the arguments Appellants set forth at pages 11-15 and 18-20 of the Appeal Brief in support of the patentability of claims 1 and 11. In this regard, Appellants submit

that the Examiner merely repeated, verbatim, selected portions of DAVIS and JAIN without any explanation whatsoever as to how these selected portions relate to the claimed subject matter, and without addressing the arguments Appellants set forth in the Appeal Brief.

In this regard, at page 11 of the Examiner's Answer, the Examiner asserts that it would have been obvious to have modified JAIN's result, "i.e. the metadata may be output in a variety of formats such as (VDF), HTML, XML, SMIL and other" into DAVIS's teaching. The Examiner goes on to assert that the motivation for this modification is "because [DAVIS and JAIN] are from the same field of endeavor", and cites col. 2, lines 7-18 of DAVIS, which discloses that his invention is "suited for use by the average consumer."

Appellants respectfully submit that their claims do not recite a feature regarding the format in which metadata is output (such as VDF, HTML, XMIL, SMIL, etc.). Thus, Appellants submit that the Examiner's discussion of Jain's metadata output format does not support the 35 U.S.C. §103(a) rejection.

Further, Appellants submit that the mere fact that two references may be from the same field of endeavor is not, by itself, sufficient reason, suggestion or motivation to combine the references. That is, Appellants submit that there must be some suggestion in the references as to the desirability for such combining. Appellants further submit that the fact that DAVIS discloses that his invention is "suited for use by the average consumer" in no way whatsoever suggests a reason, suggestion or motivation for modifying it with the teaching of another reference.

For at least these reasons, Appellants respectfully submit that the Examiner has failed to set forth a justifiable rationale for the 35 U.S.C. §103(a) rejection of independent claims 1 and 11.

Rejection of dependent claims 2-4, 12, 13 and 21-27 under 35 U.S.C. §103(a) over DAVIS et al. (U.S. Patent No. 5,969,716) in view of JAIN et al. (U.S. Patent No. 6,360,234)

With respect to dependent claims 2-4, 12, 13 and 21-27, at pages 12-14 of the Examiner's Answer, the Examiner repeats the same arguments, verbatim, as he set forth regarding independent claims 1 and 11. The Examiner does not address the separate arguments Appellants made with respect to the patentability of these dependent claims.

Appellants respectfully submit that dependent claims 2-4, 12, 13 and 21-27 are allowable for the same reasons as independent claims 1 and 11, as well as for the individual reasons set forth in the Appeal Brief of February 23, 2006 (which are incorporated herein by reference), which the Examiner does not address in the Examiner's Answer.

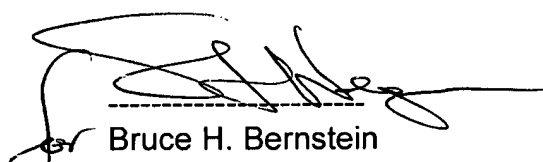
CONCLUSION

Accordingly, for each and all of the reasons noted herein and in the Appeal Brief of February 23, 2006, Appellants submit that the rejections of claims 1-4, 11-13 and 21-27 under 35 U.S.C. §103(a) is inappropriate and unsupported by the proposed combination of DAVIS et al. and JAIN et al. Therefore, Appellants respectfully request that the decision of the Examiner to reject claims 1-4, 11-13 and 21-27 under 35 U.S.C. §103(a) be reversed, and that the

application be returned to the Examiner for withdrawal of the rejections, and an early allowance of claims 1-4, 11-13 and 21-27 on appeal.

Should the Examiner or the Board of Patent Appeals and Interferences have any questions, they are respectfully requested to contact the undersigned at the telephone number provided below.

Respectfully submitted,
Toshihiko MUNETSUGU et al.



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July 14, 2006
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